



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,234	09/09/2003	Seppo Reino Keronen	00169.001469.3	8842

5514 7590 10/27/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,234

Applicant(s)

KERONEN ET AL.

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-95 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 46-95 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/414,558.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the response filed on 8/23/2005, which has been entered in the file. Claims 46-95 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 46, 48-53, 56-67, and 70-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier (WO 95/35534, cited by applicant) in view of Redford et al (US 6,327,459 B2).

Combaluzier teaches a system, method, and computer program including a card (3) adapted to be inserted into a card reader/computer device (control housing 1) that communicates with another device (an electrical apparatus, for example, radios,

electrical communication apparatus with station search, digital telephone networks, bar code readers, see page 8, lines 13-21), the card comprising: selectable indicia (14) on a surface of the card, a storage device (chip 18) storing data associated with the indicia wherein selection of one of the indicia while the card is inserted into the reader causes accessing of the corresponding data in the card, the system necessarily includes a card customizing apparatus for customizing the card (for example: an apparatus at the place of manufacture of the card), the card customizing apparatus comprising a processor for handling the first and second information, the processor being configured to write the data into the memory of the card (the information is written at the time of manufacture of the card), wherein the card storing the data is printed by a writer device connected to the card customizing apparatus (the indicium 14 is printed on the card at the time of manufacture), wherein the card reader obtains the selected information dependent upon selection of the indicium (when the user presses one of the keys 13) and sends the second information to the other device, the card reader includes a processor (9) for obtaining the data from the storage device on the card (see figures 1, 2, 5-9, page 3 line 26 - page 4 line 21, page 5 lines 1-7, page 6 line 14 - page 9 line 27).

Combaluzier fails to specifically teach the card reader communicating with a computer device, storing memory references relating to an external memory device, accessing of the memory references causes accessing of corresponding data/service stored in the external memory device using the memory reference, wherein the computer device receives the selected memory reference from the card via the card reader and communicates with the external memory device over a communication

network using the selected memory reference to access dependent upon a selected indicium the corresponding data, wherein the external memory device is a server, the memory references being associated with corresponding web pages, the memory references being URL's, the memory references being telephone numbers.

Redford et al teaches a system and method including a card (publication 11 may be a card, see column 8 lines 11-19 and 49-60) adapted for insertion into a card reader (remote control 10) that communicates with a computer device (host device 120, figure 3A, column 8 lines 20-31), the card comprising a memory (an electronic chip, for example, see column 9 lines 59-64) storing memory references (an identification code, for example) relating to an external memory device (a server or storage media, see column 4 lines 26-32), the memory references being associated with selectable indicia (text/graphics, see figure 3A) on a surface of the card, wherein selection of one of the indicia while the card is inserted into the reader (remote control 10) causes accessing of corresponding data stored in the external memory device, wherein accessing the memory references causes accessing of corresponding data/services stored in the external memory device using the memory reference (the identification code may contain an Internet address in the form of a URL, see column 14 lines 41-45), a processor (while the processor is not shown, a processor is necessarily present, in order to program the electronic chip on the publication 11 at the time of manufacture) configured to write the memory references into the storage device of the card, wherein the computer device (120) receives the selected memory reference from the card via the card reader and communicates with the external memory device over a

Art Unit: 2876

communication network (see column 4, lines 25-32) using the selected memory reference to access the corresponding data/services, wherein the external memory device is a server (131, figure 2B), the memory references being associated with corresponding web pages (see column 4, lines 25-32), the memory references being URL's (see column 4, lines 25-32), the memory references being telephone numbers (see column 15, lines 58-67) (also see figures 1, 2A-2C, 3A, column 2 lines 55-59, column 3 lines 35-46, 65-67, column 4 lines 11-32, column 4 line 64 - column 5 line 8, column 8 lines 1-31, 49-60, column 9 lines 59-64, column 14 lines 40-48 and column 15 lines 58-67).

In view of Redford et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Combaluzier, the card reader communicating with a computer device, storing memory references relating to an external memory device, accessing of the memory references causes accessing of corresponding data/service stored in the external memory device using the memory reference, wherein the computer device receives the selected memory reference from the card via the card reader and communicates with the external memory device over a communication network using the selected memory reference to access dependent upon a selected indicium the corresponding data, wherein the external memory device is a server, the memory references being associated with corresponding web pages, the memory references being URL's, the memory references being telephone numbers, in order to allow users to access external information without the need to remember or enter an Internet

address (see column 4 line 64 - column 5 line 3, of Redford et al). Furthermore, accessing an external memory allows for providing a large amount of information to the user while using a minimum amount of memory on the card.

4. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier as modified by Redford et al as applied to claim 46 above, and further in view of Masuzawa et al (US 5,015,830, cited by applicant).

Combaluzier as modified by Redford et al fails to specifically teach the first information and the second information being inputted from a keyboard.

Masuzawa et al teaches the use of a keyboard (21) for inputting data to be written to a card (50) (see figures 1, 5, 6, column 1 lines 11-20, and column 5 lines 21-30).

In view of Masuzawa et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Combaluzier as modified by Redford et al, the first information and the second information being inputted from a keyboard, in order to utilize a simple and well established means/method of entering data to be stored in a card.

5. Claim 54, 55, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier as modified by Redford et al and further in view of Cohn et al (US 6,308,202 B1, cited by applicant).

The teachings of Combaluzier as modified by Redford et al have been discussed above. Combaluzier also teaches the card reader having a transparent touch sensitive membrane (the keys 13 are made of a touch sensitive membrane) through which a

plurality of indicia (14) of an inserted card (3) are visible (see figures 1, 2, 5-9, page 3 line 26 - page 4 line 21, page 5 lines 1-7, page 6 line 14 - page 9 line 27).

Combaluzier as modified by Redford et al fails to specifically teach the computer device being a set top box having an application to provide a service, the application being loaded on the set top box, and a display that displays a web page.

Cohn et al teaches a control unit (28) that communicates with a computer device (22), the control unit sending information to the computer device, the computer device receiving the information from the control unit and using the information to obtain a service via a communication line/computer network (32, 34, 10) from an external site (a site connected to the Internet 10), wherein the computer device is a set top box having an application to provide the service, the application being loaded on the set top box, the set top box is connected to the Internet (10), a display (24) that displays a web page (see figures 1-3, column 3 line 17 - column 4 line 31).

In view of Cohn et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Combaluzier as modified by Redford et al, the computer device being a set top box having an application to provide a service, the application being loaded on the set top box, and a display that displays a web page, in order to provide the ability to use the card reader to control a set-top box, in addition to the computer devices as taught by Combaluzier as modified by Kitagawa et al, thereby increasing the versatility/functionality of the system.

Response to Arguments

6. Applicant's arguments filed 8/23/2005 have been fully considered but they are not persuasive.

In response to applicant's assertion that, in Redford et al, "The leaf carries a pattern containing an identification code, which can be in the form of a bar code, a series of holes or an encoded magnetic stripe." (see pages 4-5 of the response filed on 8/23/2005), the examiner would also like to note that Redford et al specifically states that the identification code may be stored in an electronic chip carried by the leaf 11 (see column 9, lines 59-62. of Redford et al).

In response to applicant's argument that Redford et al is not seen to disclose or suggest that memory references associated with indicia on a surface of a card relate to an external memory device; Redford et al is not seen to disclose or suggest that selection of one of the indicia causes corresponding data stored in the external memory device to be accessed; Redford et al is not seen to disclose or suggest the attendant benefits provided by the storage of such memory references (see page 5 of the response filed on 8/23/2005); the examiner respectfully disagrees. Redford et al teaches, in one example, that touching the content "CHINA AIRLINES" of a card generates a remote control signal that instructs a host device to automatically display electronic content accessible to the host device through a server or a storage media packaged with the insert and inserted into the host device (see column 4, lines 21-32, of Redford et al). Thus, in this example, the electronic content associated with the "CHINA AIRLINES" indicia on the card is retrieved from either a server coupled to the host or a

storage media inserted into the host, when the user selects the "CHINA AIRLINES" indicia on the card. In either case, both the server and the storage media can be considered an external memory device since they are both external of the card. The identification code of the card/leaf is used along with touch location information to retrieve specific electronic content from an external memory device. Thus, the identification code is an external memory reference that is associated with the indicia on the card/leaf. The identification code may include an Internet address in the form of a uniform resource locator (see column 14, lines 43-45, of Redford et al), which is clearly an external memory reference. In view of Redford et al's teachings, one of ordinary skill in the art at the time of the invention would recognize that the benefit of using external memory references is to allow access to a greater amount of electronic content than can be stored on the card/leaf itself. Thus, in view of Redford et al's teachings, one of ordinary skill in the art at the time of the invention would have been motivated to utilize memory references relating to an external memory device, in order to allow the user to access a greater amount of electronic content and/or permit the use of a card/leaf with a small amount of memory, which would naturally be less expensive than a card/leaf with a larger amount of memory.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2876

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jared J. Fureman
Primary Examiner
Art Unit 2876

October 20, 2005